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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,537	09/22/2003	John Frederick Heck	LUC-424/Heck 4-1	9945
32205	7590	11/01/2005	EXAMINER	
CARMEN B. PATTI & ASSOCIATES, LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			LAM, DUNG LE	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,537

Applicant(s)

HECK ET AL.

Examiner

Dung Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-6,8,11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The references listed in the Information Disclosure Statement submitted on March 02, 2005 have been considered by the examiner (see attached PTO-1449 form). Please note that the listed prior art document number "2003/040300" is missing a zero, it should be changed to --2003/0040300--).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **7, 10-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Berger et al.** (US Pub. No. 2003/0152203) in view of **Muhonen** (WO 99/66746).

3. Regarding **claim 7**, **Berger** teaches a method for delivering at least a portion of a multimedia message originated by a multimedia messaging service, MMS, enabled handset to a non-MMS enabled handset comprising the steps of (Abstract, para. 14, 15, 29 and 37):

receiving the multimedia message (MMS) containing a voice portion at a message server in a mailbox assigned to a recipient of the multimedia message (para. 14);

However, Berger fails to teach the step of determining if the recipient utilizes an MMS enabled handset; if the recipient utilizes an SMS enabled handset, causing an SMS notification message to be generated and transmitted to the recipient's handset; if the recipient utilizes an SMS enabled handset, causing an SMS notification message to be generated and transmitted to the recipient's handset.

In an analogous art, **Muhonen** teaches the step of storing the message at a message server in a mailbox assigned to a recipient message (page 21, lines 24-25), the step of determining if the recipient utilizes an MMS enabled handset (page 24 lines 26-29 and page 25 lines 13-15, page 21); Muhonen further teaches that sometimes the recipient may not want to or not able to receive the message due to inadequate memory of the handset (page 21, lines 2-5) which provides the motivation for sending a notification message that contains more details about the message and makes it easier for recipients to decide whether or not to retrieve the message (page 15, lines 16-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine **Berger's** method of sending a MMS message with Muhonen's teaching of sending a notification of the awaiting message prior to actual transmission of the message to increase bandwidth efficiency by sending out the message when the message is requested and receivable by the recipient.

Berger further teaches the step of:

transmitting the information contained in the multimedia message to the recipient utilizing a communication mode supported by the non-MMS enabled handset of the recipient (para. 35).

the notification message communicating to the recipient that a message is awaiting delivery to the recipient (para. 15); upon receipt of an independent, conventional voice channel cellular call from the recipient at the message server seeking access to the multimedia message awaiting delivery in the recipient's mailbox (para. 45-47), transmitting at least a portion of the information contained in the multimedia message to the recipient (para. 47) utilizing a communication mode supported by the non-MMS enabled handset of the recipient (para. 44).

4. Regarding **claim 10**, it is an apparatus claim of a message server corresponding to the method claim 7. Therefore, it is rejected for the same reasons as (see claim 7 above).

5. Regarding **claim 13**, **Berger and Muhonen** teach the method according to claim 7. **Berger** further teaches the voice portion is the representation of the spoken words by a calling party. The voice portion being stored in a conventional voice mailbox in the message server associated with the recipient party (voice message, para. 14, 15, 29 and 37).

6. Regarding **claim 14**, **Berger and Muhonen** teach the message server according to claim 10. **Berger** further teaches the voice portion is the representation of the spoken words by a calling party, the message server further

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comprising a conventional voice mailbox associated with the recipient party that stores conventional voice mail (para. 14, 15, 29 and 37).

7. Claims **9 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Berger et al.** (US Pub. No. 2003/0152203) in view of **Muhonen** (WO 99/66746) further in view of **Eales et al.** (US Pub. No. 2005/0083940).

8. Regarding **claim 9**, **Berger and Muhonen** teach a method according to claim 7. Muhonen further teaches that the multimedia message contains at least a first message portion and wherein the method comprises further steps of determining if the recipient's handset is capable of receiving the communication mode utilized by said first message portion (page 24 lines 26-29 and page 25 lines 13-15, page 21, lines 2-5). However, they fail to explicitly teach that and upon determining that the recipient's handset is not capable of receiving the communication mode, generating a notice message transmitted to the recipient's handset informing the recipient that a portion of the multimedia message could not be communicated to the recipient. In an analogous art, **Eales** teaches that upon receiving a MMS message destined for a legacy (non-MMS) handset, a message is forwarded to the receiving legacy handset notifying the receiver of an MMS message awaiting to be delivered (col. 5, para. 82). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to add to **Berger and Muhonen's** teachings the notification feature as taught by **Eales** to increase the quality and compatibility in messaging between SMS and MMS handsets.

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9. Regarding **claims 12**, it is an apparatus claim of a message server corresponding to the respective method claims 9. Therefore, it is rejected for the same reasons as (see claim 9 above).

Response to Amendment

Applicant's arguments filed 8/29/05 with respect to claims 7-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Lam whose telephone number is (571) 272-6497. The examiner can normally be reached on M - F 9 - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL


SONNY TRINH
PRIMARY EXAMINER